

### REMARKS/ARGUMENT

Claims 1-4, 6-9 and 12 are pending. The specification has been amended as to a matter of form kindly pointed out in the Office Action. Claims 5, 10 and 11 have been cancelled without prejudice. Claims 4 and 9 have been amended. Claims 1, 4 and 9 are the only independent claims.

Initially, Applicant notes that the Examiner did not return initialed copies of the PTO-1449 forms filed with the original application papers or with the submission dated June 20, 2001. It is requested that the Examiner initial those papers and return them in the next Office Action. For the convenience of the Examiner, duplicates of those PTO-1449 forms are submitted herewith.

Applicant also notes that paragraph 1 of the Office Action incompletely acknowledges the filing of the certified copy of the priority document in this application. The Office Action states that "The certified copy has been filed in parent Application No. 336474/1998." However, the number listed by the Examiner is the application number of the Japanese priority document, not of any "parent" application. The certified copy of the priority document was in fact filed together with the initial application papers in *this* case and Applicant requests acknowledgment of its filing in the next Office Action.

The drawings were objected to because they did not include reference numerals 741 and 742. As shown above, new drawings have been submitted. Figure 2 has been amended to add these reference numerals. No new matter has been added. Withdrawal of the objection is respectfully requested.

The drawings were also objected to because they included reference numeral S6, which was not mentioned in the specification. As shown above, the specification has been

amended to include that reference numeral, without adding new matter. Withdrawal of the objection is respectfully requested.

Claims 4-8 were rejected under 35 U.S.C. § 103 over Nanjo (JP 406119363A), which is the art discussed in the Background of the Invention of the specification. Claims 1-3 were rejected under 35 U.S.C. § 103 over Nanjo in view of Tabata (JP410143414A). Claims 9-12 were rejected under 35 U.S.C. § 103 over Nanjo in view of U.S. Patent 6,401,206 (Khan et al.). Applicant submits that the claims are patentable over the cited references for at least the following reasons. The independent claims will be discussed in the same order in which they were addressed in the Office Action.

Amended claim 4 is directed to document management system comprising: a plurality of computer systems coupled together by a network, at least one of the computer systems delivering an electronic document attached with a signature image for authorizing the electronic document by a signer, a document data storage system coupled to the network for storing the electronic document supplied from the at least one of the computer systems, and an attest data storage system coupled to the network for storing the signature image. The document data storage system stores bar codes of a document number of the electronic document stored in the document data storage system and an ID number of the attest data storage system storing the attest data. The attest data storage system stores bar codes of the document number and an ID number of the document data storage system. The document management system stores bar codes of a document number of the electronic document stored in the document data storage system and an ID number of the attest data storage system storing the attest data, the attest data storage system storing bar codes of the document number and an ID number of the document data storage system.

Nanjo is extensively discussed in the background section of the present application. Nanjo teaches, inter alia, a system that delivers document data after synthesizing the

document data with signature image data. In the Office Action, the Examiner recognized that Nanjo does not teach the storing of bar codes for storing of ID numbers of attest data storage system, document data storage system, and a document number of the electronic document. To remedy this deficiency, the Examiner relied upon Tabata et al. Tabata discloses document storage for storing electronic documents with a three-dimensional bar code.

To support a prima facie case of obviousness requires that each and every feature of the claim in question be taught or suggested by the prior art. Each and every word of the claim must be given patentable weight. Moreover, the features of the claim must be found in the very same relationship to one another as is claimed. Further, a motivation must be identified, in the prior art itself, that would have caused one of skill in the art to make any proposed modification of the primary reference or to combine references.

In the Office Action, in reference to claim 1, which also recites the above-mentioned features, the Examiner took the position that it would have been obvious to combine Tabata et al. with Nanjo to provide the features relating to the use of barcodes “because it would allow the use of barcodes as a means to record document management information and attest management information to an electronic document management system.”

This statement, far from identifying the required motivation, fails identify *any motivation whatsoever*. It is simply a conclusory statement that is the same as saying that it would have been obvious to add claimed feature because: then you then would have the claimed feature. “Because it would allow the use of barcodes” is not a motivation to modify Nanjo to use barcodes and such a statement cannot be considered adequate to support an obviousness rejection. *Having* barcodes certainly would *allow the use of* barcodes. However, that is *not* a reasoned statement of *why* one of ordinary skill in the art would have been motivated to modify Nanjo so as to include barcodes.

The only motivation for adding barcodes to Nanjo's system is the motivation to meet this feature of the claim, which is, of course, improper, and in fact amounts to a hindsight reconstruction of the claim. In view of the failure of the Office Action to provide *any* legally acceptable motivation for the recited barcodes, no prima facie case of obviousness for this feature has been set forth. Accordingly, claim 4 is believed patentable over the cited art.

As discussed above, claim 1 recites a similar feature and is believed patentable for at least the same reasons as claim 4.

Claim 9 is directed to a method for managing an electronic document in a computer network system comprising the steps of registering a signature image data in association with a signer ID number, temporarily storing primary document data including an electronic document having therein a signature image, in association with the signer ID number, transferring the registered signature image data based on the signer ID number in the primary document data, attaching the registered signature image data to the primary document data to complete a secondary document data, which includes a system ID number of a system registering the signature image data, to be stored, and storing a system ID number of a system storing the secondary document data in association with the registered signature image data.

Claim 9 has been amended to recite the features of now-cancelled claims 10 and 11. In the Office Action, with reference to those claims, the Examiner recognized that the combination of Nanjo and Khan et al. failed to teach the storing of ID number of system registering image data with the secondary document data and system ID number of system storing secondary document data with the signature image data. However, the Examiner took the position that it would have been obvious to include the above features because "of the added efficiency of system identification means."

The fact that the applicant's invention increases efficiency is *not* evidence that is would have been obvious to have added the feature that promotes such efficiency. On the contrary, the fact that the prior art has no teaching or suggestion of a feature, combined with the fact that the feature is particularly advantageous, is evidence of *non*-obviousness, not its opposite. If the rule followed in the Office Action were followed, then the most advantageous inventions would be the most obvious. Of course this is not true.

The Examiner has failed to provide a reasoned statement as to why one of ordinary skill in the art would have been motivated to modify the combination of references to include the claimed features. The fact that a recited feature is advantageous cannot be held against the applicant and cannot substitute for the motivation that must be shown by the Examiner. If the Examiner intends to maintain this rejection, he is requested to explain exactly what teachings in the prior art would have motivated someone to make the modification. It was the applicant who discovered the advantageous claim features and the Examiner has offered no evidence whatsoever that such advantages were recognized in the prior art so as to provide for a possible motivation for its modification. As such, no *prima facie* case of obviousness has been set forth.

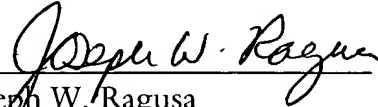
For at least the above reasons, claim 9 is believed patentable over the cited references.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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